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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/674,682	11/03/2000	Peter Berrie	36-1368	1560
7590 11/30/2004				
Nixon & Vanderhye 1100 North Glebe Road 8th Floor Arlington, VA 22201-4714			EXAMINER MEHRA, Inder P	
			ART UNIT 2666	PAPER NUMBER

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/674,682

Applicant(s)

BERRIE ET AL.

Examiner

Inder P Mehra

Art Unit

2666

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2004 and 25 June 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-7, 13 and 15-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-7, 13 and 15-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

1. This is in response to amendment dated 6/14/04, and supplemental amendment dated 6/25/04. Based on these amendments, claims 1, 8-12 and 14 have been cancelled. Claims 2-7, 13, 15-20 are pending.

#### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 4, 5, 7, 13, 18, 19, 20, rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. Claim 4 recites the limitation "the step of arranging a telephone network billing system" in line 2. There is insufficient antecedent basis for this limitation in the claim.
- b. Claim 5 recites the limitation "said dialed interface telephone number" in line 3.
  4. There is insufficient antecedent basis for this limitation in the claim.
- c. Claim 7 recites the following limitations:
  - "said ascertained dialed interface telephone number" in line 8. "said dialed interface telephone number", in lines 7, 10 and 13, and "said address" in line 15.

There is insufficient antecedent basis for this limitation in the claim.

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d. Claim 13 recites the limitation "said address" in line 14. There is insufficient antecedent basis for this limitation in the claim.

e. Claim 18 recites the limitation "said dialed interface telephone number" in line 4. There is insufficient antecedent basis for this limitation in the claim.

f. Claim 19 recites the following limitations:

- "said telephone number" in line 8.
- "said connection service" in line 11.
- "said address" in line 13.

There is insufficient antecedent basis for this limitation in the claim.

g. Claim 20 recites the following limitation:

- "a telephone network" in line 2. This limitation is preceded in claim 19 , in line 8.
- "said dialed interface telephone number" in lines 4-5.

There is insufficient antecedent basis for this limitation in the claim

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 2-3, 7, 13, 15-16 and 18-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Soderheim, Mattias (EP 0762707 A2), hereinafter, Mattias.

For claims 13, 18-20, Mattias discloses, in reference to fig. 1), "a method of providing a connection service between a terminal (personal computer) and a data network (Internet) said terminal (personal computer) and said telephone network ----connected said data network (Internet) through an interface (interface pool), refer to Abstract (57) on front page, page 1 lines 34-40, page 2 lines 22-24, and page 4 lines 1-3, said method comprising the steps of:

- in response to said terminal dialing an interface telephone number, -----  
connection through said telephone network -----interface, (a personal  
computer is connected via the telecommunication network---IP network, refer  
to Abstract (57) on front page; col. 1 lines 34-36 and col. 2 lines 22-24;
- said interface ascertaining said dialed interface telephone number from said  
telephone network (allows a user to connect --from telecommunication  
network to the --network, refer to col. 2 lines 32-34, and filter (part of  
interface) allows the calling user----access to the server (part of network)

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where the access check takes place (ascertaining dialed interface telephone number, refer to col. 2 lines 50-51);

- said interface checking that said dialed interface telephone number is one or more valid interface telephone numbers associated with connection server (user's IP number (dialed number) shall be blocked i.e that access only shall be allowed to the server again, refer to col. 3 lines 4-6, col. 4 lines 5-10 and lines 48-53 and col. 5 lines 1-6;
- in the event that said dialed interface telephone number is one of said valid interface telephone numbers, said interface allocating a data network address to said terminal and transmitting said address to said terminal, (allocating an IP number, i.e IP-address, refer to col. 2 lines 44-46 and 55-58);
- said interface (interface pool) providing a connection between said terminal and said data network, refer to col. 2 lines 31-33.

For claims 2, and 15, Mattias discloses all the limitations of subject matter as recited in claims 1 and 8, as above, including limitation, "wherein in said step of said interface ---terminal- ----data network, said connection is associated with a predefined set of data network addresses in said data network", (arranging special profiles (lists) over which IP-network addresses are allowed---for certain user---profiles are predefined-----used), refer to col. 3 lines 29-38.

For claims 3, and 16, Mattias discloses all the limitations of subject matter as

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recited in claims 1 and 8, as above, including limitation, "each said valid interface telephone number -----pre-defined set of data network addresses, (user is by the modem pool allocated (dynamically allocated) an IP- number, i.e an IP address), refer to col. 2 lines 44-46.

For claim 7, Mattias discloses all the limitations of subject matter, as explained in paragraph 5 above, including the following limitations:

- said data network access means (interface pool) ascertaining said dialed interface telephone number, (allows a user to connect –from telecommunication network to the –network, refer to col. 2 lines 32-34, and filter (part of interface) allows the calling user----access to the server (part of network) where the access check takes place (ascertaining dialed interface telephone number, refer to col. 2 lines 50-51);
- passing said ascertained dialed interface telephone number to said authorization means, the filter (interface pool) allows the calling user to the server where the check takes place 0, refer to col. 2 lines 49-50);
- said authentication means checking that said dialed interface telephone number is one or more valid interface telephone numbers associated with said connection service (user's IP number (dialed number) shall be blocked i.e that access only shall be allowed to the server again, refer to col. 3 lines 4-6, col. 4 lines 5-10 and lines 48-53 and col. 5 lines 1-6;
- in the event that said dialed interface telephone number is one of said valid interface telephone numbers, said authentication means causing said data

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network access means to allocate a data network address to said terminal and to transmit said address to said terminal, (allocating an IP number, i.e IP-address, refer to col. 2 lines 44-46 and 55-58), the user's IP number (address) shall be blocked i.e that access only shall be allowed, refer to col. 3 lines 4-6.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4-6, and 17 rejected under 35 U.S.C. 103(a) as being unpatentable over **Soderheim, Mattias** (EP 0762707 A2), hereinafter, Mattias, as applied to claims 1, 8 and 14 above, and further in view of **Ronen, Yzhak** (EP 0765068 A2), hereinafter, Yzhak.

For claims 4-5, , Mattias discloses all the limitations of subject matter, as explained in paragraph 5 above, with the exception of the following limitations:

- arranging a telephone network billing system to charge for access to each said valid interface telephone number at an associated pre-defined tariff, as taught by claim 4;
- said telephone network is arranged to associate said dialed interface telephone number with a further interface telephone number, said further interface telephone number being used to complete said connection, as recited by claim 5;



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Yzhak discloses the following limitations:

- arranging a telephone network billing system to charge for access to each said valid interface telephone number (bill their customers, refer to col. 1 lines 20-21) at an associated pre-defined tariff, as taught by claim 4, (time- usage basis after a financial payment relationship has been established, refer to col. 1 lines 20-22), refer to col. 4 lines 50-55 ;
- said telephone network is arranged to associate said dialed interface telephone number with a further interface telephone number, said further interface telephone number being used to complete said connection, as recited by claim 5 (virtual telephone number, refer to col. 2 lines 12-25);

It would have been obvious to a person of ordinary skill in the art at the time of the invention to use the capability of billing system and further telephone number to complete the call. The capability can be implemented by combining the billing system and further telephone connection arrangement, as taught by Yzhak, with the interface. The suggestion/motivation to do so would have been to provide a payment mechanism.

For claims 6, and 17, Mattias discloses all the limitations of subject matter, as explained in paragraph 5 above, including the following limitations:

- said interface ascertaining said terminal telephone number, (allows a user to connect --from telecommunication network to the --network, refer to col. 2 lines 32-34, and filter (part of interface) allows the calling user----access to the server (part of network) where

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the access check takes place (ascertaining dialed interface telephone number, refer to col. 2 lines 50-51);

Mattias does not disclose explicitly, the following limitations:

- said interface checking that said terminal telephone number is not one of one or more invalid terminal telephone numbers, associated with said connection, ISP collects user's Automatic Number Identification (ANI), if ----does not match the ANI provided to ISP, refer to col. 9 lines 15-20;
- in the event that said terminal telephone number is not one of said one or more invalid terminal telephone numbers-----denying a connection between said terminal and said data network (denied access (step 609), refer to col. 9 lines 20-25

It would have been obvious to a person of ordinary skill in the art at the time of the invention to use the capability of checking the identification of the user to complete the call. The capability can be implemented by combining the authorization check up arrangement, as taught by Yzhak, with the interface. The suggestion/motivation to do so would have been to provide a secured connection after verification of identification number.

### ***Response to Arguments***

8. Applicant's arguments filed 6/25/04 have been fully considered but they are not persuasive.

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Claim 13 combined with claim 18 constitute limitations same as in original claim 1.

Similarly claim 19 combined with claim 20 constitute limitations of claim 1. Previous office action sustains.

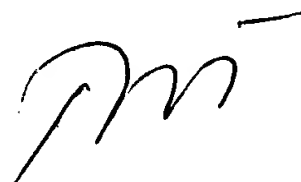
### *Conclusion*

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Inder P Mehra whose telephone number is 571-272-3170. The examiner can normally be reached on Monday through Friday from 8AM to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema Rao can be reached on 571-272-3174. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Inder Pal Mehra*  
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Art Unit 2666



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